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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,476	09/29/2006	Darwin He	NL 040347	9560
24737 7590 12/22/2008 PHILIPS INTELLECTUAL PROPERTY & STANDARDS P.O. BOX 3001 BRIARCLIFF MANOR, NY 10510				
EXAMINER ROBINSON BOYCE, AKIBA K				
ART UNIT 3628		PAPER NUMBER		
MAIL DATE 12/22/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/599,476

Applicant(s)

HE ET AL.

Examiner

AKIBA K. ROBINSON BOYCE

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Due to communications filed 9/29/06, the following is a non-final first office action. Due to a pre-amendment filed 9/29/06, claims 1-16 have been cancelled. Claims 17-28 have been added. Claims 17-28 are pending in this application and have been examined on the merits. Claims 17-28 are rejected as follows.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 17-22, and 28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 17-22 are directed to a series of steps. In order for a series of steps to be considered a proper process under § 101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Thus, to qualify as patent eligible, these processes must positively recite the other statutory class to which it is tied (e.g., by identifying the apparatus the accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g., by identifying the product or material that is changed to a different state). Claims 17-22 identify neither the apparatus performing the recited steps nor any

transformation of underlying materials, and accordingly are directed to non-statutory subject matter.

For a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result.

As per claim 28, this claims discloses: "Software operable to implement the method according to claim 17". However, the claims do not specifically disclose a medium, what type of medium this software is recorded on. In order for software to complete the necessary steps for carrying out a method of data processing, it must be embodied on a medium that is read by a computer. Since no computer readable medium exists, it is not possible for the software to be executed, and therefore not possible for a concrete or tangible result to be produced. This claim is therefore considered non-statutory.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 17-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koczmar et al (US 5,202,550), and further in view of Siepen (US 2004/0254886 A1), and further in view of Adolph (US 6,356,836).

As per claim 17, 23, 24, 28, Koczmar et al discloses:

(a) arranging for the service provider (80) to distribute one or more data carriers (20) for retail in return for payment to the provider (80),

(b) arranging for the apparatus (10) to include a memory device (30) susceptible to receiving the one or more data carriers (20), (Col. 1, lines 11-14, data carrier supplied with data in an initialization station/memory);

(c) presenting the one or more data carriers to the memory device (30) for enabling the apparatus (10) via the device (30) to directly access data (60) recorded on the one or more data carriers (20), wherein the data (60) includes at least one secured number (60) for conveying information for identifying the one or more data carriers (20), the at least one secured number (60) being maintained in a secure keylocker structure (200) recorded on the one or more data carriers (20), said keylocker (200) being accessible to the service provider (80) on presentation of a valid access key to the apparatus (10), (Col. 3, lines 25-33, data carriers read/write memory is scanned, and col. 4, lines 5-14, shows initialization station has memory that stores individual numbers assigned to each data carrier along with associated data and the data can be detected by calling up the individual number, and col. 9, lines 12-19, shows data carrier can send a special ID by means of a key, which therefore suggests that data is secure data);

Kocznar et al does not specifically disclose the following, however Siepen discloses:

(d) communicating the data (60) including the at least one second number via the apparatus (10) to the provider (80), ([0020]encrypted data transmitted to rights analysis unit);

(e) receiving the data at the provider (70, 80) and checking thereat validity of the data (60), ([0019] and [0020], encrypted data is decrypted) and [0022], [0024], encrypted data transmitted and checked to see if user of toll road is authorized).

Siepen discloses the above limitations for the purpose of showing that a data carrier can be used for transmitting encrypted data to be interpreted.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to communicate and receive secured data at the provider with the motivation of securely receiving data that is specific to a particular data carrier.

Neither Koczmar et al nor Siepen disclose the following, however, Adolph discloses:

(f) updating a toll credit for the apparatus (i0) according to information conveyed in the data (60) when the data (60) is found by the provider (70, 80) to be valid, (col. 11, lines 16-32, shows using data carrier to update values of transmitted data and transfer a corresponding credit). Adolph discloses this limitation in an analogous art for the purpose of showing that a reimbursement of fees paid for data transmitted by a participant to a central computer.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to update a toll credit according to information conveyed in the data when the data is found to be valid with the motivation of showing that reimbursement of fees are dependent on transmitted data.

As per claim 18, Koczmar et al discloses:

wherein the one or more data carriers (20) are susceptible to optical and/or magnetic interrogation for reading the data (60) therefrom, (col. 4, lines 15-26, magnetic/optical form).

As per claims 19, 27, neither Koczmar et al Siepen, nor Adolph disclose wherein the one or more data carriers (20) are one or more small form factor optical (SFFO) disks data carriers, however, all three references teach the use of data carriers to transmit data pertaining to vehicle tolls.

However, official notice is taken that it is old and well known in the data transmission art to utilize a small form factor optical disk data carrier. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to utilize a small form factor optical disk data carrier with the motivation of using a commonly used type of data carrier for most accurate data transmission.

As per claim 20, Koczmar et al does not specifically disclose including a step of communicating the data (60) on the data carrier (20) to the service provider (80) in encrypted form, however discloses storing individual numbers assigned to each data carrier along with associated data and the data can be detected by calling up the individual number in col. 4, lines 5-14, and also shows data carrier can send a special ID by means of a key in col. 9, lines 12-19, which therefore suggests that data is secure data.

However, Siepen discloses encrypted transmission of useful data in [0004]. It therefore would be obvious to combine the teachings of Koczmar and Siepen to disclose

including a step of communicating the data (60) on the data carrier (20) to the service provider (80) in encrypted form.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to disclose encrypted form with the motivation of using cryptography to transmit data.

As per claim 21, Neither Koczmar et al nor Siepen disclose wherein the service provider (80) is operable to check for earlier invocation (90) of the data (60) directly accessed from the one or more data carriers (20), thereby identifying whether or not credit represented by the one or more data carriers (20) has earlier been credited in association with the apparatus (10), however, Koczmar et al discloses a data carrier for transmission of data.

However, Adolph discloses the determination of a route based on earlier routes taken in col. 13, lines 20-33. Adolph also discloses reimbursement of fees paid for route data transmitted by a participant to a central computer in col. 11, lines 16-32. It therefore would be obvious to combine the teachings of Koczmar et al, Siepen, and Adolph to disclose wherein the service provider (80) is operable to check for earlier invocation (90) of the data (60) directly accessed from the one or more data carriers (20), thereby identifying whether or not credit represented by the one or more data carriers (20) has earlier been credited in association with the apparatus.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to disclose wherein the service provider (80) is operable to check

for earlier invocation (90) of the data (60) directly accessed from the one or more data carriers (20), thereby identifying whether or not credit represented by the one or more data carriers (20) has earlier been credited in association with the apparatus with the motivation of not duplicating a credit.

As per claims 22, 26, Kocznar et al does not specifically disclose wherein the one or more data carriers (20) include advertisement data content (300) and/or at least one advertisement software application (300) for presenting advertisement material to a user (40) of the apparatus (i0) when the one or more data carriers (20) are presented to the device (30), however does disclose a data carrier for data transmission.

However Siepen discloses that radio programs, hotel and restaurant information can be included in data transmitted with a data carrier as shown in [0016], lines 6-9. It therefore would be obvious to combine the teachings of Kocznar et al and Siepen to disclose wherein the one or more data carriers (20) include advertisement data content (300) and/or at least one advertisement software application (300) for presenting advertisement material to a user (40) of the apparatus (i0) when the one or more data carriers (20) are presented to the device (30).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to disclose wherein the one or more data carriers (20) include advertisement data content (300) and/or at least one advertisement software application (300) for presenting advertisement material to a user (40) of the apparatus (i0) when the one or more data carriers (20) are presented to the device (30) with the motivation of showing that more than one type of data can be transmitted by the data carrier.

As per claim 25, Kocznar et al discloses:

for conveying the data (60), the carrier (20) being susceptible to being read directly by the device (30), wherein the data (60) is recorded in a secure keylocker structure (200) of the carrier (20), (Col. 3, lines 25-33, data carriers read/write memory is scanned, and col. 4, lines 5-14, shows initialization station has memory that stores individual numbers assigned to each data carrier along with associated data and the data can be detected by calling up the individual number, and col. 9, lines 12-19, shows data carrier can send a special ID by means of a key, which therefore suggests that data is secure data);

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 571-272-6734. The examiner can normally be reached on Monday-Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

•Patent Application Information Retrieval (PAIR) system, Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

A. R. B.
December 20, 2008

/Akiba K Robinson-Boyce/
Primary Examiner, Art Unit 3628